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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/996,512

11/28/2001

Frode Bjelland

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3472

27045

7590

04/15/2005

ERICSSON INC.  
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EXAMINER

HOM, SHICK C

ART UNIT

PAPER NUMBER

2666

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/996,512

Applicant(s)

BJELLAND ET AL. 

Examiner

Shick C Hom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/28/01, 5/22/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/22/02</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Specification***

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Objections***

2. Claims 5-7 are objected to because of the following informalities: in claim 5 line 1 spell out acronym GPRS, i.e. delete "a GPRS" and insert ---a General Packet Radio Service, GPRS---. In claim 6 line 3, the words "an indication that a change" seem to refer back to the "indication that a change" recited in claim 1 lines 11-12. If this is true, it is suggested changing "as indication that a change" to ---the indication that the change ---. Claim 7 is objected to because it depends from objected claim 6. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. Claims 6-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

In claim 6 line 2 which recite "a set of identifying parameters" is not clear as to whether it is referring back to the "set of identifying parameters" recited in claim 1 lines 4-5 or a second set of identifying parameters. Claim 7 is rejected under 35 U.S.C. 112, second paragraph because it depends from rejected claim 6.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Iseyama (6,192,232).

Regarding claim 1:

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Iseyama discloses the method in a communication system of transferring control of a user-plane entity from a first control-plane entity to a second control-plane entity (see Fig. 1 and col. 5 line 62 to col. 6 line 5 which recite control being transferred to the second base station controller as the mobile station moves into its service zone), comprising the steps of: sending, by the user-plane entity to the first control-plane entity, a set of identifying parameters (see col. 8 line 54 to col. 9 line 12 which recite the first base station controller, i.e. first control-plane entity, receiving request to originate a call from the mobile station, i.e. user-plane entity); sending, by the first control-plane entity to the second control-plane entity, the set of identifying parameters (see abstract and col. 1 line 59 to col. 2 line 15 which recite the first base station controller requesting the second base station controller to make a radio connection between the mobile station and the second base station when a request to originate an emergency call is received); determining, in the second control-plane entity, whether the user-plane entity can be controlled by the second control-plane entity; and if the user-plane entity can be controlled by the second control-plane entity, then sending, by the second control-plane entity to the user-plane entity, an indication that a change in control-plane

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entities has occurred and that at least some resources of the user-plane entity that were controlled by the first control-plane entity are to be controlled by the second control-plane entity (see col. 6 lines 17-22 and col. 10 lines 17-23 which recite the second base station controller sending a message to the mobile station indicating that the assignment of an idle radio channel is completed and that a handoff can be carried out).

Regarding claims 2, 3, and 7:

Iseyama discloses wherein the first control-plane entity sends the set of identifying parameters to the second control-plane entity based on a location of a remote terminal in communication with the user-plane entity and wherein the first control-plane entity sends the set of identifying parameters to the second control-plane entity based on a status of the first control-plane entity (see col. 5 lines 35-61 which recite sending message requesting handoff if the mobile station changes its service zone and upon the communication status of the mobile station such as when level of radio wave has fallen below a predetermined level).

Regarding claim 4:

Iseyama discloses wherein the first control-plane entity sends the set of identifying parameters to the second

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control-plane entity based on relative loads in the first and second control-plane entities (see col. 16 lines 23-26 which recite because of congestion in the service zone the call from the mobile station is maintained clearly reads on sending parameters being based on relative loads in the first and second control-plane entities; i.e. the control-plane entities being changed based on relative loads).

Regarding claim 6:

Iseyama discloses wherein the step of sending, by the user-plane entity to the first control-plane entity, a set of identifying parameters is executed in response to receiving, by the user-plane entity, an indication that a change of control-plane entity is required (see col. 6 lines 16-36 which recite the controller sending to the mobile station that an idle channel is available for handoff and the mobile station then carries out the handoff).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iseyama (6,192,232) in view of Boudreaux (6,466,556).

Regarding claim 5:

For claim 5, Iseyama discloses all the subject matter of the claimed invention with the exception of wherein the communication system is a GPRS network and the set of identifying parameters are sent in a Forward Relocation Request



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message from the first control-plane entity to the second control-plane entity.

Boudreaux from the same or similar fields of endeavor teach that it is known to provide wherein the communication system is a GPRS network (see col. 3 lines 9-29 which recite the use of network being of GPRS architecture that supports GPRS packet sessions) and the set of identifying parameters are sent in a Forward Relocation Request message from the first control-plane entity to the second control-plane entity (see col. 7 lines 3-13 which recite sending Relocation Request message to the controller for control of the handover process). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide wherein the communication system being a GPRS network and the set of identifying parameters being sent in a Forward Relocation Request message from the first control-plane entity to the second control-plane entity as taught by Boudreaux in the communication method of Iseyama. The communication system being a GPRS network and the set of identifying parameters being sent in a Forward Relocation Request message from the first control-plane entity to the second control-plane entity can be implemented by providing the GPRS network including the use of Forward Relocation Request message of Boudreaux in the

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communication method of Iseyama in order to provide a network and system in which the transferring of control method can function as designed.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shin discloses a method for controlling a radio access bearer in a communication system.

Einola et al. disclose location update method and inter core network entity handover method.

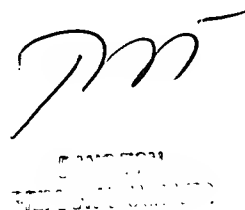
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick C Hom whose telephone number is 571-272-3173. The examiner can normally be reached on Monday to Friday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH

A handwritten signature, possibly "Jm", is written in black ink. Below the signature is a faint, rectangular stamp with illegible text.